

REMARKS

Claims 13, 15-21, 23-29, 31-34, 36-47, and 50-52 are pending in the present application. In the subject office action, all of the claims were rejected under 35 USC §103(a) as being unpatentable over U.S. published application 2002/0026394 (hereinafter “Savage”) in view of U.S. Patent 6,839,687 (hereinafter “Dent”). However, Applicants note that claim 16 was simply omitted from the subject office action, and that several limitations from the pending claims are not taught or suggested in the art cited by the Examiner. Accordingly, Applicants respectfully traverse the pending rejections and request that the claims be allowed in their current form. Remarks explaining Applicants’ traversals and in support of the patentability of the pending claims are set forth below. To the extent that the Examiner does not determine that the pending claims recite patentable subject matter in light of the remarks set forth below, the Applicants respectfully request that the Examiner suggest any amendments to the claims which might allow the Examiner and Applicants to reach an agreement on such patentable subject matter.

The Pending Claims Recite Limitations Not Taught or Suggested in the Cited Art

For a claim to be rejected under 35 U.S.C. § 103, it is necessary that a reference or combination of references teaches or suggests each limitation recited in that claim. Regarding Savage, Applicants note that, while that reference contains multiple references to formatting a bill, it does not contain disclosure which addresses the specific limitations which are recited in the pending claims. Particularly, Savage does not teach the limitations related to the creation and use of statement presentation codes, currently recited as elements (a)(i)(1-4), (a)(ii) and (a)(iv) in claim 13, as elements (a)(i)-(ii), (a)(iv) and (c) in claim 27, and as elements (a)(i)-(ii), (a)(iv), (b), and (f) in claim 40. Indeed, Applicants note that the subject office action stated “Savage fails to explicitly teach a section code, a summary line, a sorting indication,” which are recited as attributes of a statement presentation code in elements (a)(i)(1-3) of claim 13. Thus, the pending rejections can only be maintained if Dent teaches or suggests the elements which are absent from Savage. However, upon review, Applicants submit that Dent does *not* include the necessary teaching or suggestion. The passage of Dent cited as teaching one or more limitations from the pending claims (column 10, line 26 – column 11, line 31) is related to allowing a customer to challenge items on a bill, but is simply not relevant to formatting a billing statement form as claimed. While Dent does mention a bill format, the format is not a flexible format arrived at by

assigning statement presentation codes to sections as recited in element (a)(iv) in claims 13, 27 and 40. Instead, Applicants submit that the format referred to in Dent is a set format for displaying pre-arranged dispute reasons. This is made clear by lines 8-18 of column 11 of Dent, which states that a bill includes

...[t]hree columns of pre-arranged dispute reasons for non-payment or partial payment of an item. The dispute columns include a “tax exempt” column 118 that is checked if the item should not have been taxed, a “special order column 120 that is checked if the product has been ordered but not yet received, and a “no receipt” column 122 that is checked if the consumer has not yet received the goods. With this bill format, the consumer can examine each purchase, line by line. If the consumer desires to challenge an item, the consumer simply clicks or otherwise selects the appropriate column cell.

Thus, while Dent refers to a bill format, that reference does not include any teaching or suggestion sufficient to remedy the deficiencies of Savage. Accordingly, because not all limitations in the pending claims are taught or suggested in the art cited by the Examiner, the rejections of those claims under 35 U.S.C. § 103(a) are improper and should be withdrawn.

No Motivation to Modify or Combine the Cited References Has Been Provided

For a claim to be rejected under 35 U.S.C. § 103, even if all limitations recited in that claim are taught or suggested in a combination of references, it is necessary for the Examiner to show that some teaching, suggestion or motivation existed in the prior art to combine the cited references to obtain the invention claimed. MPEP 2143.01. In this case, while the subject office action conceded that not all limitations from the pending claims are taught in Savage, it did not provide a teaching, suggestion or motivation to modify Savage, either by combining it with the teachings of Dent, or by altering the features already present in Savage, to achieve the invention recited in the pending claims. For example, in rejecting claim 27, the subject office action stated that

Savage fail [sic] to explicitly teach [sic] a creating a summary segment, creating an itemization segment, creating a usage detail segment, and creating a tax segment.

However, Dent discloses a graphical user interface window containing an electronic billing statement presented by the payment analyzer on display. The billing statement is for a fictitious company Crown Home Improvement Center. The bill has a main body portion that lists individual line items for each purchase at Crown Home Improvement Center, with each line item containing the purchase date, purchase order number, invoice number, item number, description of item,

quantity, price, total, tax, and amount due. (See Fig 8-9 and column 10 lines 26-67 and column 11 lines 1-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time [sic] the invention to modify the teachings of Savage to include [sic] a creating a summary segment, creating an itemization segment, creating a usage detail segment, and creating a tax segment taught by Dent in order to display [sic] bill statement with [sic] a creating a summary segment, creating an itemization segment, creating a usage detail segment, and creating a tax segment.

Such a laundry list, followed by a broad, conclusory statement that “it would have been obvious” is representative of the justifications provided for combining Savage and Dent, and is insufficient as a matter of law for making out a *prima facie* case of obviousness. Thus, the obviousness rejections of the pending claims based on Savage in view of Dent should be withdrawn, and the claims rejected based on that combination should be allowed in their present form.

General Remarks

Applicants note that claim 16 was simply omitted from the subject office action. Applicants further note that the rejection of claim 15 was improperly combined with the rejection of claim 13, even though claim 15 recites limitations not found in claim 13. *See* MPEP § 707.07(d) (“A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.”). Additionally, despite the requirement that when a claim is rejected as obvious, “the pertinence of each reference, if not apparent, must be clearly explained” (37 C.F.R. § 1.104(c)(2)) the subject office action repeatedly stated that limitations supposedly taught or suggested in Savage were found somewhere in paragraphs 13-115 of that reference. This is inconsistent with both the requirements of 37 C.F.R. § 1.104, and with the goal of the examination process to “to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” MPEP § 706. Accordingly, the finality of the rejections in the subject office action should be withdrawn, as Applicants have not been provided with the opportunity to respond to the rejections of the pending claims.

Applicants note that the subject office action did not address the substance of the arguments presented in Applicants’ previous responses, instead stating on page 11 that they were

“moot in view of new grounds of rejections [sic].” However, the previous office action, which was mailed on January 26, 2007, set forth the same grounds of rejection as are set forth in the subject office action. Therefore, the arguments made in response to the previous office action are equally applicable to the subject office action. Applicants do not concede that those arguments have been traversed to shown to be faulty. Instead, Applicants maintain those arguments and submit that they provide further reasons why the pending claims should be allowed. Further, Applicants submit that the “conclusion” section of the subject office action, rather than explaining the pending rejections, simply restated the rejections that had been set forth previously, explaining nothing. This is inconsistent with MPEP §707.07(f), which states that “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it” and provides an additional reason why the rejections presented in the subject office action should be withdrawn.

Applicants submit that the above discussion does not constitute an exhaustive list of the novel limitations found in the pending claims which are not taught or suggested in the art of record. To the extent that the applicants have not addressed certain aspects of the present rejection, please do not construe the same as an admission as to the merits of the rejections. Similarly, while the remarks set forth herein have addressed the rejections over Savage in view of Dent, these remarks should not be construed as admissions of the prior art status of either of those references. Indeed, Applicants reserve all rights with respect to arguments not explicitly raised herein. Further, to the extent the Examiner believes that there are amendments which, if made, would allow one or more claims to issue, Applicants respectfully request that the Examiner suggest such amendments because, while the examiner has the duty to only allow valid claims, “the examiner should never overlook the importance of his or her role in allowing claims which properly define the invention.” MPEP § 706.

Conclusion

In light of the arguments made herein, it is respectfully submitted that the claims of the present application meet the requirements of patentability under 35 U.S.C. § 103(a). Accordingly, reconsideration and allowance of these claims are earnestly solicited. Applicants encourage the Examiner to contact their representative, William Morriss at (513) 651-6915 or wmorriss@fbtlaw.com if any issues remain as to the patentability of one or more of the pending claims.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

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